

REMARKS

Claims 1-13 are pending in this application.

Claims 1 and 7 are independent claims.

Foreign Priority

Foreign priority was claimed in a document submitted March 19, 2004. The Examiner is requested to acknowledge this claim for foreign priority.

Information Disclosure Statement

The indication that the two Information Disclosure Statements previously filed have been considered is noted.

Reply to Rejections

Claims 1, 3-4 and 5-6 were rejected under 35 USC 103(a) as being unpatentable over Clark (USP 4,332,430) in view of Kobayashi (USP 4,907,991). This rejection is traversed.

At least correctly recognizing that Clark does not show or suggest that the contact portions (17) do not extend in a parallel direction to the terminal body, the Examiner relies on Kobayashi.

The reasoning the Examiner presents is that it would have been obvious to modify the connecting portions of Clark to mount them directly on the printed circuit as shown in Kobayashi instead of going through holes in the printed circuit as Clark shows. But this

is speculation. For example in Clark, connection could be made to a top surface of the printed circuit without the necessity of the contact portions in Kobayashi. In fact, this is part of the disclosed admitted prior art and the problem with the admitted prior art is that the tab is of a greater height than necessary. See for example, the paragraph bridging pages 1 and 2 of the specification which explains this problem.

Also, there is no *prima facie* case of obviousness established. While it was the Examiner's assertion that it would be obvious to use the connections 12 in Kobayashi instead of the contact portions in Clark, here the Examiner is directing attention to the individual parts and not the combination as a whole. This was addressed by the Federal Circuit in the case of Hybritech Inc. v. Monoclonal Antibodies Inc. 231 USPQ 81, 93 (Fed. Cir. 1986) [cited in the MPEP] wherein the Court stated as follows:

Focusing on the obviousness of substitutions and the differences instead of the invention as a whole... was a legally improper way to simplify the difficulty termination of obviousness.

Also, as explained in the present specification, the present claimed device provides a result that must be taken into consideration in arriving at a conclusion of obviousness. See The Gillette Co. v. S.C. Johnson & Son, Inc. 16 USPQ2d 1923, 1928 (Fed. Cir. 1990) wherein the Court stated as follows:

An analysis of obviousness of a claimed combination must include consideration of the results achieved by that combination. As we explained in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). [Cited in the MPEP.]

With respect to the dependent claims, these claims are considered patentable at least for the same reasons as their base or intervening claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection under 35 USC 103.

New Claims

New claims 7-13 have been added.

Claim 7 is substantially similar to original claim 1 and is considered patentable for the reasons advanced in the reply to the rejection of claim 1, supra. Claims 8 and 9 depend from new claim 7. In claim 8, it is recited that "the extension portion has a width less than the width of the tab terminal at the point the extension portion extends from the tab terminal." This is shown for example in Figures 1 and 2 of the present specification. This feature is not shown or suggested by the references applied.

Claim 9 has the feature that the first and second portions extend in a direction toward each other. This is shown for example in Figure 1 wherein elements 1E extend toward each other. This

feature is not shown or suggested by the references applied. Claims 10 and 11 are similar to claims 8 and 9 but depend from claim 1 and are considered patentable at least for the same reasons as claim 1 and additionally for the reasons of the added features in claims 10 and 11 as explained with respect to claims 8 and 9.

Claims 12 and 13 are dependent on claims 9 and 11, respectively. The claims are considered patentable at least for the same reasons as claims 9 and 11.

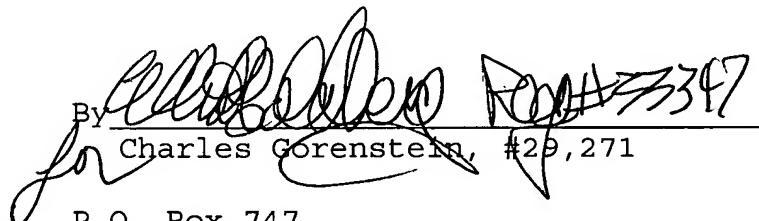
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  Rep # 3347
for Charles Gorenstein, #29,271

CG/EAG/jm/slb
1131-505P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000